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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,045	12/05/2003	James V. Lovenstein	PTK-235	9318
51414	7590	06/30/2006	EXAMINER FERGUSON, MARISSA L	
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 06/30/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/729,045  
Filing Date: December 05, 2003  
Appellant(s): LOVENSTEIN ET AL.

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Mark Beloborodov  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/7/06 appealing from the Office action  
mailed 11/2/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The statement of the status of claims contained in the brief is correct.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

This appeal involves claims 1-10.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,688,227	Zerillo	02-2004
6,729,235	Kerr	05-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***DETAILED ACTION***

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zerillo (US Patent 6,688,227) in view of Kerr (US Patent 6,729,235).

Regarding claims 1 and 6, Zerillo teaches a retention device (50) for securing a recording medium (55) to a rotatable, magnetically susceptible cylinder (60), the retention device being configured for releasable attachment to the cylinder (Column 4, Lines 31-35) over the recording medium and at least one magnetic element (90). However, he does not explicitly disclose a retention device with a curved surface complimentary to the curvature of the cylinder. Kerr teaches a curved retainer device (55,57) that holds a sheet material. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Zerillo to replace the flat retention device thereof with a curved retainer as

taught by Kerr, since Kerr teaches that it is advantageous to properly secure sheets of material.

Regarding claims 2 and 7, Zerillo teaches a retention device comprising a plurality of magnetic elements (90) distributed over the surface.

Regarding claims 3 and 8, Zerillo teaches magnetic elements that are recessed within the device so as not to protrude beyond the surface (Figure 5).

Regarding claims 4 and 9, Zerillo teaches an entire magnetic surface (Figures 1, 5 and 8).

Regarding claims 5 and 10, Zerillo teaches a removable handle (75) to facilitate application and removal of the retention device.

#### **(10) Response to Argument**

Claims 1-10 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Zerillo in view of Kerr.

On page 4 of the brief, Appellant argues, "merely piecing together elements from the prior art to defeat the patentability of a claimed invention is inappropriate". The examiner notes that it is appropriate to combine references when there is a proper motivation to do so. In the present case, there is proper motivation for combining Zerillo and Kerr.

Both references teach a clamp or retention device that retains a sheet material to a surface of a drum/cylinder. One having ordinary skill in the art would recognize that modifying Zerillo as proposed by the examiner would improve the device of Zerillo by improving its ability to properly secure sheets of material. The teaching for this

modification is found in Kerr, which clearly shows that a curved retainer device is beneficial for holding a sheet material on a curved surface. Therefore, the arguments are not sufficient to overcome the 103(a) rejection of the claims.

With respect to the arguments, "As recognized in the final Office action, Zerillo does not teach or suggest a retention device having "a curved surface complementary to a curvature of the cylinder" claimed by Appellants", the examiner would like to point out that Zerillo appears to teach a curved retention device (50) as shown in figures 1, 4 and 5. However, since the reference does not explicitly teach the limitation, the examiner combined the reference with Kerr to meet the claimed invention.

With respect to Appellant's arguments on page 5, second paragraph, the examiner maintains the retainer device 50 of Kerr as a whole shows a curvature. One of ordinary skill in the art would recognize that the curved shape of the retainer of Kerr is beneficial for assuring that the ends of the device are in close proximity to the surface upon which the device 50 is secured. Therefore, one having ordinary skill in the art would be motivated to modify Zerillo as proposed above, to improve the retainer of Zerillo by assuring its ends are sufficiently close to the surface upon which the retainer is secured.

The retainer device in figure 15b (refer to figure on page 6) clearly shows the device (50) and surfaces 56,57 following the curved surface of the drum (28), thereby retaining the sheet material. It is very apparent that if the retaining device 50 did not have an overall curvature to match the curvature of the cylinder/drum 28, the retaining device would not function effectively to secure sheet material to the cylinder/drum 28.

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This teaching is clearly applicable to the retaining device of Zerillo, and one having ordinary skill in the art would recognize that the clamp of Zerillo would be improved by having curvature to match the cylinder/drum thereof. Again, it is the examiner's opinion that the modification is proper whether or not the retaining element of Zerillo is curved (prior to being modified by Kerr). It appears, however, that the retaining element of Zerillo is curved (refer to figures 3 and 5 on page 7), although this is not expressly set forth by the reference.

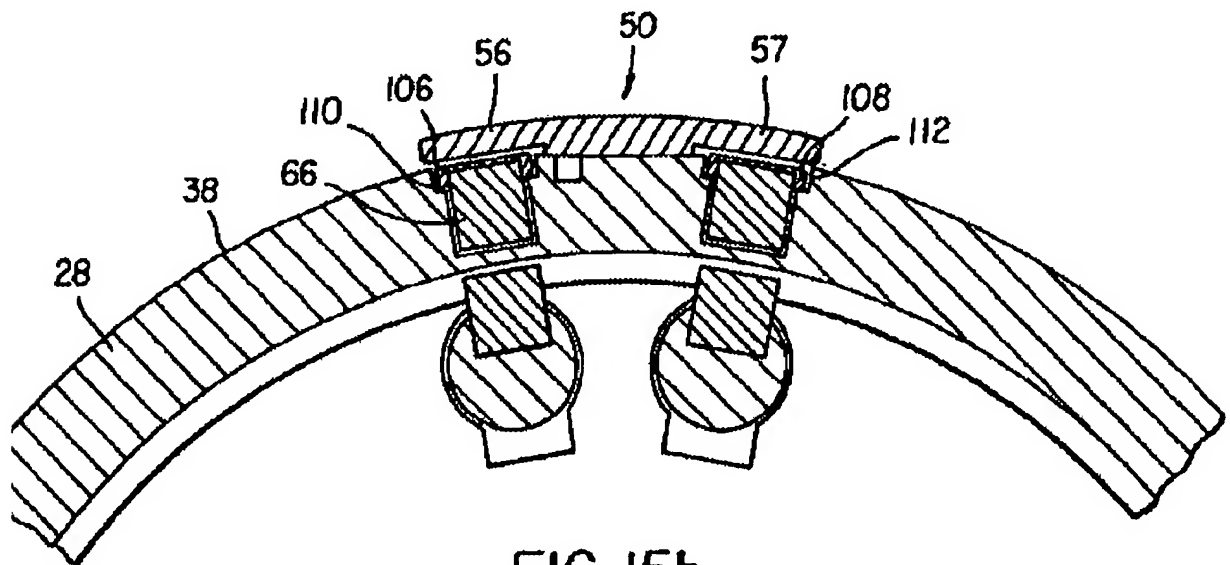


FIG. 15b

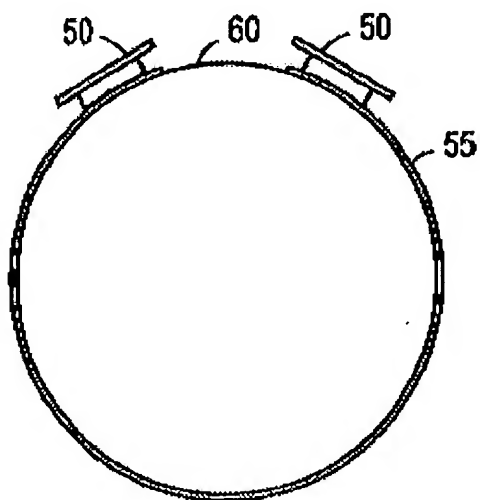


FIG. 3

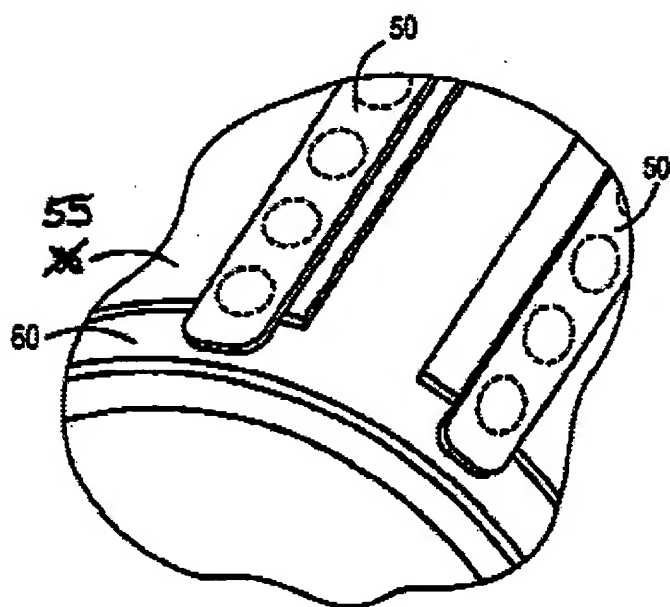


FIG. 5



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MFS

6/23/06

Conferees:

*AHH*  
Andrew Hirshfeld  
Darren Schuberg *DS*  
Marissa Ferguson-Samreth *MFS*

*Andrew H. Hirshfeld*  
**ANDREW H. HIRSHFELD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**

GOODWIN PROCTER, LLP  
Exchange Place  
Boston, MA 02109